

RECEIVED
CENTRAL FAX CENTER
JAN 18 2005

E
&
A **EDWARDS & ANGELL, LLP**

COUNSELLORS AT LAW
since 1894

DIKE, BRONSTEIN, ROBERTS & CUSHMAN
Intellectual Property Practice Group

MARLBOROUGH, MA OFFICE
TELEPHONE (508) 485-7772

WASHINGTON, DC
TELEPHONE (703) 553-2563

MAILING ADDRESS:
P.O. BOX 55874
BOSTON, MA 02205

101 FEDERAL STREET
BOSTON, MA 02110
(617) 439-4444
FAX (617) 439-4170

FACSIMILE TRANSMITTAL

DATE: January 18, 2005

TO: U.S. Patent & Trademark Office
Examining Group 2800

FAX NO.: 1-703-872-9318

FROM: Steven M. Jensen

FAX NO.: 617-439-4170

Our Docket No.: 60173 (71987)

No. of Pages (incl. cover): 3

Re: U.S. Serial Number 10/696,198

MESSAGE:

Please enter the attached response.

NOTICE

The message and/or information which accompanies this facsimile cover sheet is intended for the addressee named above only. If you are not the intended recipient, please contact the sender by collect telephone at the number indicated. You will be advised regarding the disposition of what you have received. The mis-delivery of the message and/or information which accompanies this facsimile cover sheet is not intended to be and shall not constitute a disclosure of trade secrets, of attorney work product or of an attorney-client communication. No waiver of any privilege is intended. Thank you for your attention to this matter.

BOSTON HARTFORD NEWPORT NEW YORK PALM BEACH PROVIDENCE SHORT HILLS

Docket No. 60173 (71987)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED
CENTRAL FAX CENTER

JAN 18 2005

APPLICANT: C. Huang

U.S. SERIAL NO: 10/696,198

EXAMINER: H. Trinh

FILED: October 28, 2003

GROUP: 2814

FOR: MULTI-CHIP PACKAGE DEVICE WITH HEAT SINK AND
FABRICATION METHOD THEREOF

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted by facsimile to Group 2800 of the U.S. Patent & Trademark Office by facsimile number 703-872-9318 on January 18, 2005.

By: 
Steven M. Jensen

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir/Madam:

RESPONSE TO OFFICE ACTION

Applicant is in receipt of the Office Action dated December 15, 2004 of the above-identified application. This response is timely filed, because January 16, 2005 was a Sunday, and January 17, 2005 was a federal holiday.

In response to the Restriction Requirement, Applicant provisionally elects Group I, claims 1-8, with traverse. The present election is made solely to comply with the Office Action and should not be construed as a surrender of any subject matter of the application. Applicant reserves the right to file divisional application(s) on the non-elected claims.

C. Huang
U.S. Serial No. 10/696,198
Page 2 of 2

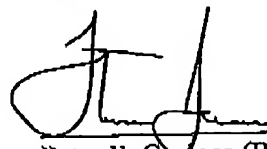
Applicant traverses the Restriction Requirement on the basis that, while the claims of Groups I and II are drawn to a multi-chip package device and a fabrication method, respectively, the Examiner has failed to demonstrate that the product as claimed can be made by "another and materially different process." According to MPEP §806.05(f), it is permissible to define a product in terms of a process by which it is made, in order to define the invention.

It was stated on page 2 of the Office Action: "In the instant case the product as claimed can be made with another materially different process such that the process includes the step of **forming an external device**" (emphasis added).

However, the proposed step of "forming an external device" falls outside the scope of the Applicant's claimed invention. For example, in the specification it is stated that solder balls 313 provide "electrical connection of the package device 3 with an external device (not shown)" (page 8, lines 19-20). In other words, the step of forming an external device is not shown in the drawings, and does not fall within the scope of the Applicant's claimed invention. Moreover, claim 1 (of Group I) does not require "forming an external device" but instead merely recites: "a chip carrier for electrically connecting the semiconductor package device to an external device" (emphasis added).

Withdrawal of the restriction requirement, and early consideration and allowance of the application are earnestly solicited.

Respectfully submitted,



Peter F. Corless (Reg. No. 33,860)
Steven M. Jensen (Reg. No. 42,693)
EDWARDS & ANGELL, LLP
P.O. Box 55874
Boston, MA 02205

Date: January 18, 2005

Phone: (617) 439-4444

Customer No. 21874